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10/526,868	03/04/2005	Maarten Peter Bodlaender	NL 020826	5434

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EXAMINER

LEWIS, JONATHAN V

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,868

Applicant(s)

BODLAENDER, MAARTEN PETER

Examiner

Jonathan Lewis

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 13 is objected to because of the following informalities: "a *prioritised* order". Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 20 is rejected under 35 U. S. C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim defines a computer program embodying functional descriptive material. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason (i.e.,

"When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" - Guidelines Annex IV). That is, the scope of the presently claimed signal processing program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art Van Stam (WO 01/46843).

Regarding claim 1, Van Stam teaches a user terminal for a network (Fig. 1, 11 shows the user terminal, referred to as the client), the user terminal comprising: a local database comprising community preference information related to preferences of a community of users (Abstract discloses this claim limitation, where the local database is the lists stored within the client); a processor for determining if a communication with a second user terminal is possible (page 4, lines 8-13 disclose this functionality, and it is inherent to have a processor perform this function because it is not possible to do without one); a receiver for receiving community preference information from the second user terminal if communication is possible (page 6, lines 10-13); a database controller

for updating the database of community preference information in response to the received community preference information (page 7, lines 2-8 discloses the update in response to preference information); a recommendation processor for generating a recommendation in response to the community preference information of the local database (page 7, lines 4-5 discloses the recommendation/suggestion).

Regarding claim 2, Van Stam teaches a user terminal as claimed in claim 1 wherein the community preference information relates to media clips and the recommendation is of a media clip (page 5, line 16).

Regarding claim 3, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal is a wireless user (page 4, lines 27-28).

Regarding claim 4, Van Stam teaches a user terminal as claimed in claim 1 wherein the communication with the second user terminal is over a direct wireless link between the user terminal and the second user (page 4, lines 27-28; lines 34-36).

Regarding claim 5, Van Stam teaches a user terminal as claimed in claim 1 wherein the local database is operable to comprise community preference information related to the whole community is stored (page 5, lines 25-30).

Regarding claim 6, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal is operable to communicate community preference information from the local database to the second user terminal if communication with the second user terminal is possible (page 6, lines 21-26).

Regarding claim 7, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal is operable to communicate with the second user terminal using a peer to peer protocol (page 5, lines 32-37).

Regarding claim 8, Van Stam teaches a user terminal as claimed in claim 1 wherein the received community preference information comprises time information and the database controller is operable to update the community preference information of the local database in response to this time information (page 7, lines 2-4 disclose the time information with the recording history, and the update is the changing of the list).

Regarding claim 9, Van Stam teaches a user terminal as claimed in claim 1 wherein the community preference information comprises a user rating (page 5, line 18).

Regarding claim 10, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal further comprises means for communicating the recommendation to another user terminal (page 6, lines 21-26).

Regarding claim 11, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal further comprises an interface for receiving community preference information from the Internet (page 4, lines 22-23).

Regarding claim 12, Van Stam teaches a user terminal as claimed in claim 1 wherein the user terminal comprises a priority controller for determining a priority of elements of the community preference information and a transmitter for communicating this priority to the second user terminal (page 7, lines 33-38).

Regarding claim 13, Van Stam teaches a user terminal as claimed in claim 1 wherein the received community preference information is received in a prioritised order (page 7, lines 10-29).

Regarding claim 14, Van Stam teaches a network comprising at least one user terminal as claimed in claim 1 (Fig. 1).

Regarding claim 15, Van Stam teaches a data network as claimed in claim 14 wherein the data network is a peer to peer data network (Fig. 2).

Regarding claim 16, Van Stam teaches a data network as claimed in claim 14 wherein the data network comprises a plurality of wireless user terminals according to claim 6, and wherein at least one of the plurality of wireless user terminals are operable to receive community preference information from a fixed network and distribute the community preference information from the fixed network to other wireless user terminals (page 4, lines 27-28).

Regarding claim 17, Van Stam teaches a data network as claimed in claim 16 wherein the fixed network is the Internet (page 4, lines 22-23).

Regarding claim 18, Van Stam teaches a data network as claimed in claim 16 wherein the at least one wireless user terminal is operable to distribute the community preference information from the fixed network while disconnected from the fixed network (page 8, lines 9-20 disclose the systems are in parallel with each other, operable separately).


Method and computer program claims 19-20 are rejected for the same reasons as stated above in the corresponding apparatus and system claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Lewis whose telephone number is (571) 270-3233. The examiner can normally be reached on Mon - Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


BRIAN PENDLETON
SUPERVISORY PATENT EXAMINER